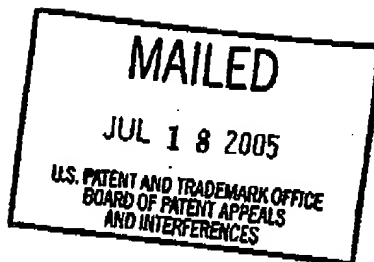


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte TRENTON M. OVERHOLT

RECEIVED  
REHRIG PACIFIC COMPANY

Appeal No. 2005-1278  
Application No. 10/145,226

JUL 20 2005

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ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 to 31, which are all of the claims pending in this application.<sup>1</sup>

We AFFIRM-IN-PART.

<sup>1</sup> Claims 12 and 20 were amended subsequent to the final rejection.

Exhibit D

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### BACKGROUND

The appellant's invention relates to a container adapted for storing, transporting, and displaying produce items and other goods (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's reply brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Overholt et al. (Overholt '054)	6,398,054	June 4, 2002
Overholt (Overholt '388)	6,386,388	May 14, 2002
Overholt et al. (Overholt '392)	D446,392	Aug. 14, 2001
Jacques et al. (Jacques '420)	5,988,420	Nov. 23, 1999
Jacques et al. (Jacques '342)	5,746,342	May 5, 1998
Capper	4,049,284	Sept. 20, 1977

U.S. Patent Application No. 10/163,004 filed June 3, 2002

Claims 12 to 31 stand rejected under the judicially created doctrine of double patenting over claims 1-22 of Overholt '388, over claims 1-21 of Overholt '054 and over figures 1-6 of Overholt '392 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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Claims 12 to 31 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 of copending U.S. Patent Application No. 10/163,004 to Overholt et al.

Claims 16, 17, 26 and 27 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 12 to 18, 26 and 27 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Jacques '342.

Claims 12 to 31 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Overholt '054.

Claims 12 to 14, 25, 26, 28, 29 and 31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Jacques '420.

Claims 15, 27 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jacques '420 in view of Jacques '342.

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Claim 19 stands rejected under 35 U.S.C. § 103 as being unpatentable over Jacques '420 in view of Jacques '342 and Capper.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (mailed May 14, 2003) and the answer (mailed March 12, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed December 29, 2003) and reply brief (filed May 20, 2004) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The double patenting rejections**

The examiner has set forth the bases for these rejections in the following manner (final rejection, pp. 5-6):

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A collapsible container arranged to hold an object having a curvature along its length, comprising a base, a first pair of opposed side walls and a second pair of opposed side walls.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A collapsible container arranged to hold an object having a curvature along its length, comprising a base, a first pair of opposed side walls and a second pair of opposed side walls. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

"Obviousness-type" double patenting is a judicially established doctrine which prevents an unjustified extension of the patent right beyond the statutory time period, that is, it extends the fundamental legal doctrine of double patenting to include "obvious variants" of what already has been patented. See, for example, *In re Berg*, 140 F.2d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998) and *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279-80, 23 USPQ2d 1839, 1845 (Fed. Cir. 1992). A rejection on the basis of obviousness-type double patenting thus

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must establish that the claims of the application would extend the rights granted to the patentee.

With regard to rejections under the doctrine of obviousness-type double patenting, the examiner is instructed by Section 804 of the Manual of Patent Examining Procedure (MPEP) as follows (emphasis added):

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined in the conflicting claims – a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in

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issue is an obvious variation of the invention defined in a claim in the patent.

The examiner therefore is required to establish that **each** application claim being rejected under the theory of obviousness-type double patenting is not patentably distinct from a claim in the applied patent or patent application in the case of a provisional rejection.

However, the examiner has not acted in accordance with this guidance in the present case. In the statement of the rejection the examiner has merely grouped together a number of claims in the application, pointed out some common features in the application claims that are present in the claims of the applied patents or patent application, and then declared that the application claims were unpatentable. It is our view that the examiner therefore has failed to establish a prima facie case of obviousness-type double patenting with regard to claims 12 to 31.

Additionally, the examiner failed to apply a "two-way" test between the design patent and the claims under appeal. The Federal Circuit stated in In re Dembiczak, 175 F.3d 994, 1002, 50 USPQ2d 1614, 1619 (Fed. Cir. 1999) that:

The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. *See Carman Indus.,*

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*Inc. v. Wahl*, 724 F.2d 932, 939-40, 220 USPQ 481, 487 (Fed. Cir. 1983) (noting that, while theoretically possible, "[d]ouble patenting is rare in the context of utility versus design patents"); *In re Thorington*, 418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969) (Double patenting between a design and utility patent is possible "if the features producing the novel aesthetic effect of a design patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure."); *In re Phelan*, 205 F.2d 183, 98 USPQ 156 (CCPA 1953); *In re Barber*, 81 F.2d 231, 28 USPQ 187 (CCPA 1936); *In re Hargraves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931). In these cases, a "two-way" test is applicable. See *Carman*, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *Id.*, 220 USPQ at 487. See also *Braat*, 937 F.2d at 593, 19 USPQ2d at 1292 (explaining two-way test).

For the reasons set forth above, the decision of the examiner to reject claims 12 to 31 under the judicially created doctrine of double patenting over claims 1-22 of Overholt '388, over claims 1-21 of Overholt '054 and over figures 1-6 of Overholt '392 is reversed and the decision of the examiner to provisionally reject claims 12 to 31 under the judicially created doctrine of double patenting over claims 1-19 of copending U.S. Patent Application No. 10/163,004 is reversed.

#### **The indefiniteness rejection**

We will sustain the rejection of claims 26 and 27 under 35 U.S.C. § 112, second paragraph, but not the rejection of claims 16 and 17.



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The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably

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ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

With this as background, the specific bases for the rejection under 35 U.S.C. § 112, second paragraph, are as follows (final rejection, p. 2):

Claim 16 recites the limitation "the second walls" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the second walls" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitation "the end walls" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitation "the end walls" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Initially, we note that none of the objected limitations actually appear in the claims. However, claims 16 and 17 include the limitation "the first and second walls" and claims 26 and 27 include the limitation "the pairs of opposed side walls and end walls." We therefore view the examiner's rejection of claims 16 and 17 as being based on the lack of antecedent basis for "second walls" and the examiner's rejection of claims 26 and 27 as being based on the lack of antecedent basis for "end walls."

In our view, antecedent basis for "second walls" is sufficiently provided by parent claim 12 which recites "a second pair of opposed side walls." As such, claims 16 and

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17 define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity as required by the second paragraph of 35 U.S.C. § 112.

However, there is no antecedent basis provided in parent claims 12 and 14 for "end walls." Parent claim 12 recites both "a first pair of opposed side walls" and "a second pair of opposed side walls" but not any "end walls." Thus, it is unclear if the claimed "end walls" are referring back to one of the pairs of side walls or reciting additional walls. As such, claims 26 and 27 do not define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity as required by the second paragraph of 35 U.S.C. § 112.

For the reasons set forth above, the decision of the examiner to reject claims 16, 17, 26 and 27 under 35 U.S.C. § 112, second paragraph, is reversed with respect to claims 16 and 17 and affirmed with respect to claims 26 and 27.

**The anticipation rejection based on Jacques '342**

We will not sustain the rejection of claims 12 to 18, 26 and 27 under 35 U.S.C. § 102(b) as being clearly anticipated by Jacques '342.

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A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it."

The appellant argues (brief, p. 10) that none of the raised profiles 32 in Jacques '342 extend longitudinally along the length of the base as required by claim 12. Therefore, claims 12 to 18, 26 and 27 are not anticipated by Jacques '342. The examiner did not respond to this argument in the answer.

Claim 12 includes the limitation of "a base having at least one raised member extending longitudinally along the length thereof for accommodating the curvature of the object." Jacques '342 teaches a bottom wall 12 (i.e., base) having a series of raised profiles 32 (six being shown) which serve as abutments for the lower part of bottles

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resting on the bottom wall 12. Each profile defines a rhomboidal configuration with concave sidewalls displaying a series of small vertical ribs 33 for reinforcement and for washing purposes. The profiles do not extend longitudinally along the length of the bottom wall. Thus, claim 12, and claims 13 to 18, 26 and 27 dependent thereon, are not anticipated by Jacques '342.

**The anticipation rejection based on Overholt '054**

We sustain the rejection of claims 12 to 19 and 25 to 31 under 35 U.S.C. § 102(e) as being clearly anticipated by Overholt '054 but not the rejection of claims 20 to 24.

The appellant argues (brief, pp. 11-12; reply brief, pp. 3) that Overholt '054 does not disclose the following limitations:

- (1) opposed sidewalls having "a central portion with a substantially smooth, non-apertured inner surface for contacting the object and reducing force thereagainst" as set forth in claim 12;
- (2) opposed sidewalls having an inner surface with "a bowed and substantially unbroken central portion" as set forth in claim 20;
- (3) opposed sidewalls or endwalls having "a central portion with a substantially smooth and unbroken inner surface above the cutout" as set forth in claim 25; and

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(4) opposed sidewalls having a "central portion having a substantially smooth, non-apertured inner surface" as set forth in claim 28.

The invention of Overholt '054 relates to a multi-purpose collapsible container adapted for storing, transporting, and displaying produce items and other goods. Referring to Figures 1, 2, 3, and 8, side walls 28, 30 of a container 10 are bowed outward, away from compartment 13, and have an arcuate shape. The central portion 74, 76 of side walls 28, 30 include the bowed (or scalloped) curvature. Side walls 28, 30, respectively, are each pivotably attached to base 12 by way of a hinging configuration or system 80. Referring now to Figures 1-2, 4, and 9, container 10 further includes a pair of opposed end walls 32 and 34. Similar to side walls 28, 30, end walls 32, 34, are also bowed in an outward manner, having an arcuate shape where the central portion 75, 77 of end walls 32, 34 include the arcuate shape. Further, like side walls 28, 30, end walls 32, 34 are similarly pivotably attached to base 12 by way of a hinging mechanism 90. The bowed features of the side and end walls generally serves to increase the interior volume 13 of container 10, thereby allowing container 10 to store and transport more product.

In reading the above-noted four limitations on Overholt '054, the examiner takes the positions (answer, pp. 7-8) that (1) the central portion 74 of Overholt '054 is not the

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central portion as defined by this rejection because central portion 74 has two rows of apertures extending from one side edge of portion 74 to the opposite side edge of portion 74; and (2) the portion of the inner surface of the portion 74 between the first and second rows is a centrally located side wall portion which is a substantially smooth, non-apertured inner surface for contacting the object and reducing force thereagainst when the container is in an assembled position.

In our view, the limitation that the opposed sidewalls have "a central portion with a substantially smooth, non-apertured inner surface for contacting the object and reducing force thereagainst" as set forth in claim 12 is readable on Overholt '054 as set forth by the examiner. That is, the portion of the inner surface of each of the central portions 74, 76 between the two rows of apertures is a central portion of the side wall with a substantially smooth, non-apertured inner surface for contacting the object and reducing force thereagainst when the container is in an assembled position.

The limitation that the opposed sidewalls or endwalls have an inner surface with "a bowed and substantially unbroken central portion" as set forth in claim 20 is not readable on Overholt '054. In that regard, while the portion of the inner surface of each of the central portions 74, 76 of Overholt '054 between the two rows of apertures is unbroken, the portion of the inner surface of each of the central portions 74, 76

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between the two rows of apertures is not bowed. Likewise, while the central portions 74, 76 of Overholt '054 are bowed, the central portions 74, 76 are not unbroken.

The limitation that the opposed sidewalls or endwalls have "a central portion with a substantially smooth and unbroken inner surface above the cutout" as set forth in claim 25 is readable on Overholt '054 as set forth by the examiner. That is, the portion of the inner surface of each of the central portions 74, 76 between the two rows of apertures is a central portion of the side wall with a substantially smooth and unbroken inner surface above the cutout.

The limitation that the opposed sidewalls have "central portion having a substantially smooth, non-apertured inner surface" as set forth in claim 28 is readable on Overholt '054 as set forth by the examiner. That is, the portion of the inner surface of each of the central portions 74, 76 between the two rows of apertures is a central portion of the side wall having a substantially smooth, non-apertured inner surface.

For the reasons set forth above, the decision of the examiner to reject claims 12, 25 and 28, and claims 13 to 19, 26, 27 and 29 to 31 dependent thereon, is affirmed and the decision of the examiner to reject claim 20, and claims 21 to 24 dependent thereon, is reversed.



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**The anticipation rejection based on Jacques '420**

We sustain the rejection of claims 12 to 14, 25, 26, 28 and 29 under 35 U.S.C. § 102(e) as being clearly anticipated by Jacques '420 but not the rejection of claim 31.

The appellant argues (brief, pp. 12-14) that Jacques '420 does not disclose the following limitations:

- (1) opposed sidewalls having "a central portion with a substantially smooth, non-apertured inner surface for contacting the object and reducing force thereagainst" as set forth in claim 12;
- (2) opposed sidewalls having "a plurality of apertures around the periphery thereof surrounding the central portion" as set forth in claim 14;
- (3) a base having a plurality of upstanding corner members each having "a contoured surface" and the opposed side walls having a second portion having "a complementary contour for mating with a corresponding contoured surface of the upstanding corner member" as set forth in claim 25;
- (4) opposed sidewalls having a "central portion having a substantially smooth, non-apertured inner surface" as set forth in claim 28;
- (5) a plurality of apertures in the peripheral portion as set forth in claim 29; and
- (6) a curved raised portion in the base as set forth in claim 31.

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Figure 8 of Jacques '420 shows a five-piece open container 210 comprising a bottom piece 212, opposite side pieces 214 and 216 and opposite end pieces 218 and 220. The side pieces 214 and 216 have two rows of apertures extending from one side edge to the opposite side edge and a solid portion therebetween. At each corner of the bottom piece 212, there is provided a post 240. Each post 240 consists of a vertically extending rectangular corner projection having a curved top wall 242 and a pyramidally shaped integral part 248 extending upwardly from the top wall 242.

In our view, the limitation that the opposed sidewalls have "a central portion with a substantially smooth, non-apertured inner surface for contacting the object and reducing force thereagainst" as set forth in claim 12 is readable on Jacques '420. In that regard, the solid portion between the two rows of apertures of each side piece 214 and 216 of Jacques '420 is a central portion of the side wall with a substantially smooth, non-apertured inner surface for contacting the object and reducing force thereagainst when the container is in an assembled position.

The limitation that the opposed sidewalls have "a plurality of apertures around the periphery thereof surrounding the central portion" as set forth in claim 14 is readable on Jacques '420 since the two rows of apertures of each side piece 214 and 216 surround the solid portion therebetween.

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The limitation that the base has a plurality of upstanding corner members each having "a contoured surface" and the opposed side walls have a second portion having "a complementary contour for mating with a corresponding contoured surface of the upstanding corner member" as set forth in claim 25 is readable on Jacques '420. In that regard, the posts 240 of Jacques '420 have a curved top wall 242 and a pyramidally shaped integral part 248 which are accommodated by opposite end pieces 218 and 220 when the container is in its erected position shown in Figure 8.

The limitation that the opposed sidewalls have "central portion having a substantially smooth, non-apertured inner surface" as set forth in claim 28 is readable on Jacques '420. In that regard, the solid portion between the two rows of apertures of each side piece 214 and 216 of Jacques '420 is a central portion of the side wall with a substantially smooth, non-apertured inner surface.

The limitation that the opposed sidewalls have "a plurality of apertures in the peripheral portion" as set forth in claim 29 is readable on Jacques '420 since the two rows of apertures of each side piece 214 and 216 surround the solid portion therebetween.

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The limitation that the base has a curved raised portion as set forth in claim 31 is not readable on the raised portion of the bottom piece 212 of Jacques '420 shown in Figure 8. While Figure 8, depicts a raised portion, such raised portion is not shown as being curved.

For the reasons set forth above, the decision of the examiner to reject claims 12, 14, 25, 28 and 29, and claims 13 and 26 dependent thereon, is affirmed and the decision of the examiner to reject claim 31 is reversed.

#### **The obviousness rejections**

We will not sustain the rejection of claims 15, 27 and 30 under 35 U.S.C. § 103 as being unpatentable over Jacques '420 in view of Jacques '342. We will not sustain the rejection of claim 19 under 35 U.S.C. § 103 as being unpatentable over Jacques '420 in view of Jacques '342 and Capper.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to

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make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

In the obviousness rejections before us in this appeal, the examiner (final rejection, p. 4) ascertained that Jacques '420 discloses the invention except for the ribs

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as set forth in claims 15, 27 and 30 and the concave shape of the inner surface of the central portion as set forth in claim 19. The examiner then concluded that in view of the teachings of ribs at the upper edge of the side walls in Jacques '342 it would have been obvious to add such ribs to the inner surface of the side walls in Jacques '420 in order to strengthen the inner surface to prevent the stress of impacts from creating stress cracks or tears at the inner surface of the inner surface of the sidewalls as this portion of the container is most susceptible to use and wear. The examiner also concluded that in view of the teachings of a concave inner surface in Capper it would have been obvious to provide a concave inner surface to the central portion of the side walls in Jacques '420 to more closely conform to the curved shape of the objects stored within the container.

In our view, the applied prior art contains no motivation, suggestion or teaching that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Jacques '420 so as to arrive at the subject matter of claims 15, 19, 27 and 30. While Jacques '342 teaches ribs at the upper edge of the side walls and Capper teaches a concave inner surface there is no incentive, absent the appellant's own disclosure, to have modified Jacques '420 in the manner set forth by the examiner.

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For the reasons set forth above, the decision of the examiner to reject claims 15, 27 and 30 under 35 U.S.C. § 103 as being unpatentable over Jacques '420) in view of Jacques '342 is reversed and the decision of the examiner to reject claim 19 under 35 U.S.C. § 103 as being unpatentable over Jacques '420 in view of Jacques '342 and Capper is reversed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 12 to 31 under the judicially created doctrine of double patenting over claims 1-22 of Overholt '388 is reversed; the decision of the examiner to reject claims 12 to 31 under the judicially created doctrine of double patenting over claims 1-21 of Overholt '054 is reversed; the decision of the examiner to reject claims 12 to 31 under the judicially created doctrine of double patenting over figures 1-6 of Overholt '392 is reversed; the decision of the examiner to provisionally reject claims 12 to 31 under the judicially created doctrine of double patenting over claims 1-19 of copending U.S. Patent Application No. 10/163,004 to Overholt et al. is reversed; the decision of the examiner to reject claims 16, 17, 26 and 27 under 35 U.S.C. § 112, second paragraph, is reversed with respect to claims 16 and 17 and affirmed with respect to claims 26 and 27; the decision of the examiner to reject claims 12 to 18, 26 and 27 under 35 U.S.C. § 102(b) as being clearly anticipated by Jacques '342 is reversed; the decision of the examiner to reject claims 12 to 31

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under 35 U.S.C. § 102(e) as being clearly anticipated by Overholt '054 is affirmed with respect to claims 12 to 19 and 25 to 31 and reversed with respect to claims 20 to 24; the decision of the examiner to reject claims 12 to 14, 25, 26, 28, 29 and 31 under 35 U.S.C. § 102(e) as being anticipated by Jacques '420 is affirmed with respect to claims 12 to 14, 25, 26, 28 and 29 and reversed with respect to claim 31; the decision of the examiner to reject claims 15, 27 and 30 under 35 U.S.C. § 103 as being unpatentable over Jacques '420) in view of Jacques '342 is reversed; and the decision of the examiner to reject claim 19 under 35 U.S.C. § 103 as being unpatentable over Jacques '420 in view of Jacques '342 and Capper is reversed.




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No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

  
CHARLES E. FRANKFORT  
Administrative Patent Judge

  
JOHN P. McQUADE  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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) BOARD OF PATENT  
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) INTERFERENCES  
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